

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

020375-047700US

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on November 6, 2008Signature / Stephanie Klepp /

Typed or printed
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Application Number

10/714,441

Filed

November 14, 2003

First Named Inventor

Amber Gravett et al.

Art Unit

3692

Examiner

Benjamin S. Fields

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 61,751

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.


Signature

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November 6, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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PATENT
Attorney Docket No.: 020375-047700US

TOWNSEND and TOWNSEND and CREW LLP

By: / Stephanie Klepp /
Stephanie Klepp

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Amber Gravett, et al.

Application No.: 10/714,441

Filed: November 14, 2003

For: OPEN LOOP STORED VALUE
ACCOUNT CONFIGURATION

Customer No.: 20350

Confirmation No.: 9387

Examiner: Benjamin S. Fields

Art Unit: 3692

ARGUMENTS FOR PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejections in the Final Office Action mailed September 18, 2008 (the "Office Action") for the above-identified application.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

Remarks**Claim Rejection Under 35 U.S.C. 103**

Claims 1-20 have been rejected under 35 U.S.C. 103(a) as being obvious over Neofytides. Applicants respectfully request the Examiner to withdraw the rejection because the Examiner has failed to state a *prima facie* case of obviousness. Indeed, to establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). Then, the Examiner must provide an explicit analysis supporting the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision September 2007. Neofytides does not show all the claim elements.

In embodiments, the present invention provides a method for **creating** an open network stored benefit account (e.g., a gift card from a particular branded credit card association, such as VISA™). In one embodiment, a first message is received at a first interface and includes a purchaser account identifier (e.g., a credit card number). The purchaser account identifier is used to fund a stored benefit account. For example, a credit charge is made to the purchaser's credit card account to fund the stored benefit account. A first message response is returned that can be used to determine if a first message response is consistent with the other account information and that the purchaser's account can validly fund the stored benefit account. A second message is received with the application interface, and the second message includes recipient account information. For example, a recipient enters his or her name, address, and other information for creating the stored benefit account. The stored benefit account is created with the recipient account information and is backed by an account issuer.

Examiner has argued in multiple previous office actions that, while Neofytides merely “encompasses the **usage** of a stored benefit account,” that is sufficient to render “the

creation of an open network stored account [] obvious.” Office Action, pp. 4 – 5. The Examiner appears to admit that there is no explicit teaching in Neofytides of creating a stored value account, but then summarily concludes that it “would make sense [sic] then, that there would be an associated stored benefit account created for the usage of such account.” Office Action, p. 5.

Essentially, Examiner’s argument seems to be that, because a stored value account had to be created *somehow* prior to being used in Neofytides, this alone obviates any and all possible ways in which the account could have been created (i.e., including the specific ways claimed in the present application). This assertion is *non sequitur* and fails to satisfy the Examiner’s *prima facie* burden. Moreover, even if Neofytides were construed to suggest account creation, there is no teaching or suggestion of the specific type of account creation recited in the claims, as evidenced by several missing limitations.

Missing Limitation: “receiving at an intermediate system, a first message to create the open network stored benefit account, the first message including a purchaser account identifier, the purchaser account identifier identifying a purchaser account, wherein the purchaser account identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account”

Independent claim 1 requires “receiving at an intermediate system, a first message to create the open network stored benefit account, the first message including a purchaser account identifier, the purchaser account identifier identifying a purchaser account, wherein the purchaser account identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account.” Neofytides does not show a message being received from a purchaser with a purchaser account identifier *to create stored value fund*.

Neofytides shows a step to open an account (Step 512 of Fig. 5). The description of this step in Fig. 5 of Neofytides states only “If the payor 110 does not remain external to the system 100, an account is opened in step 512 when there is no existing account.” Neofytides, ¶ [0052]. Or Neofytides states, “Where there is no account, one is opened by the payee 130 in step 512.” Neofytides, ¶ [0057]. The other sections cited by the Examiner do not mention opening an account or what is received to accomplish opening an account. It is readily apparent that Neofytides does not describe creating a stored benefit account as recited in claim 1.

Rather, Neofytides shows a transfer from a stored value fund. *See Neofytides*, ¶ [0021] (“A period expiring and/or a threshold amount being met can cause the *transfer of money in or out of the stored value fund.*” (*Emphasis added.*)). Therefore, Neofytides does not teach receiving a first message including a purchaser account identifier to create a stored value account. Claim 1 is allowable over Neofytides for at least this reason.

Missing Limitation: “the intermediate system determines from the first message response if the purchaser account associated with the purchaser account identifier can validly fund the stored benefit account”

Independent claim 1 also requires “the intermediate system determines from the first message response if the purchaser account associated with the purchaser account identifier can validly fund the stored benefit account.” Neofytides does not include an intermediate system and does not show a step of determining if the purchaser account (e.g., a credit card account of the purchaser) can fund the stored value benefit account. Rather, Neofytides simply adds money into the stored value account. *See Neofytides*, ¶ [0072] (“Where there is not sufficient funds in the stored value fund, processing *continues to step 816 to load funds.*” (*Emphasis added.*)).

This process is different than determining if a purchaser account (e.g., a purchaser’s credit card account) can provide funds into the stored value account (e.g., determine whether the credit charge to the purchaser’s account is authorized) and does not require or include an intermediate system. Therefore, Neofytides does not teach the intermediate system determining whether the purchaser account can fund the stored value benefit account. For at least this reason, claim 1 is allowable over the cited art.

Missing Limitation: “the intermediate system receiving a second message response with the application interface; the intermediate system processing the second message response, wherein: second message response includes recipient account information, the stored benefit account is created with the recipient account information”

Independent claim 1 also requires “the intermediate system receiving a second message response with the application interface; the intermediate system processing the second message response, wherein: second message response includes recipient account information, the stored benefit account is created with the recipient account information.” Neofytides does not show such a step of receiving a second message with account information from a recipient

and creating the stored value account with the account information from the recipient. In embodiments, the purchaser and the recipient are different entities. Thus, a purchaser can fund the stored benefit account for the benefit of the recipient.

Neofytides only describes credit card authorization messages that transfer money in or out of *an existing account*, not an account that is being created. See Neofytides, ¶ [0078]. These transaction messages in Neofytides are not the same. Therefore, Neofytides does not teach that the intermediate system receiving a second message that includes recipient account information or that the stored value account *is created from the account information*. For at least this reason, claim 1 is allowable over the cited art.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that independent claim 1 is allowable. Claims 8 and 15 contain similar recitations to those of claims 1 and are believed allowable for at least the same reasons as given above. Further, claims 2 – 7, 9 – 14, 16 – 20 each depend from allowable base claims and are believed allowable for at least the same reasons as given above. Applicants, therefore, respectfully request that the rejections to these claims be withdrawn and that a notice of allowance is issued at the earliest convenience.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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